

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 1-12 are pending and under examination. Applicants have amended claim 1 to indicate that "the yogurt comprises 7% to 14% (m/m) of a homogenized cream." Applicants also amended claims 6 and 10 to correct a grammatical error. Claim 5 was amended to depend on claim 3. The specification supports the amendment of claims 1 and 5 at, for example, page 12 (ll. 3-6) and page 17 (ll. 11-14) of the English specification. None of the claim amendments described above introduce new matter.

Applicants acknowledge with appreciation the Office's consideration of the references cited in the Information Disclosure Statement of November 16, 2005.

The Office has objected to claim 6 and has rejected claims 1-12 under one or more of 35 U.S.C. § 102 and 35 U.S.C. § 103. Applicants address these objections and rejections below.

**II. OBJECTIONS TO THE CLAIMS**

The Office objects to claim 6, requesting that Applicants amend this claim by adding the word "in" after "claimed" in the first line. Office Action, p. 2. Applicants have amended claim 6 accordingly. Applicants request that the Office withdraw this objection.

### III. REJECTIONS UNDER 35 U.S.C. § 102

#### A. Rejection of claims 1-3, 6-10, and 12 under 35 U.S.C. § 102(b), as allegedly anticipated by Amen et al. (WO 89/02702).

The Office rejects claims 1-3, 6-10, and 12 under 35 U.S.C. § 102(b), as allegedly anticipated by Amen et al. (WO 89/02702; hereinafter R1). Office Action, p. 2. According to the Office:

3. R1 discloses the incorporation of cream into [a] fermented yogurt product which can have added flavorings. R1 discloses that pasteurized cream, flavoring agents and coloring agents can be added to the fermented yogurt. R1 further teaches that for acceptable product stability, the fat content of the product should be in the range of 8-11% by weight based on the total weight of the finished product. (page 9, lines 19-33).

4. R1 also discloses a formulation wherein cream is added to a fermented yogurt. The finished products are made in vanilla and strawberry flavorings. R1 discloses the mixing of cream into the yogurt bulk. Flavorings are then mixed into the yogurt containing cream. (Page 11-12, Example 1).

Office Action, p. 2. The Office contends that "[g]iven that a fermented yoghurt is mixed with cream, the particle diameter of free fat globules and those of the protein-fat mixed network, as presently claimed, will be *inherent* in the product so formed." Office Action, p. 3 (emphasis added). Applicants respectfully traverse.

Applicants disagree with the Office's characterization of R1, because R1 fails to teach each and every element of claims 1-3, 6-10, and 12. See M.P.E.P. §2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987)).

Applicants submit that R1 cannot expressly anticipate claim 1 because R1 does not teach each and every element of this claim at least because R1 does not disclose the "bimodal structure" recited in claims 1 and 12. Likewise, R1 also cannot expressly anticipate claims 2 and 3, which depend on claim 1.

Moreover, the Office incorrectly applies the principle of inherency against claim 2. R1 does not disclose, either expressly or inherently, free fat globules having a "particle diameter of between 0.05 and 3  $\mu\text{m}$ " and fat globules connected to the Protein-Fat mixed network having "a particle diameter of between 10 and 140  $\mu\text{m}$ ." Nonetheless, the Office reasons that, "[g]iven that a fermented yoghurt is mixed with cream, the particle diameter of free fat globules and those of the protein-fat mixed network, as presently claimed, will be inherent in the product so formed." Office Action, p. 3 (emphasis added).

Under the doctrine of inherency, however, the initial burden is on the Office to show that the claimed limitations not explicitly described in the cited prior art (R1) are nevertheless *inherent* in R1. More specifically, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See M.P.E.P. § 2112 (IV). Moreover, the M.P.E.P. cautions the Office that

"[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference . . . . Inherency, however, *may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"

*In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999) (emphasis added). See also M.P.E.P. §2112(IV). In other words, for inherent anticipation to exist, the missing descriptive element must be necessarily and inevitably present in R1.

However, Applicants respectfully submit that the Office has not met its burden of identifying extrinsic evidence, or indeed any basis, to explain why mixing fermented yogurt with cream necessarily and inevitably results in the diameter sizes recited in claim 2. In addition, R1 does not show that its specific compositions necessarily and inevitably have the recited bimodal structure of claim 2, much less that the bimodal structure would have free fat globules and connected fat globules with the specific particle diameters of claim 2.

Regarding process claim 6 and dependent claims 7-10, R1 cannot anticipate these claims because R1 does not expressly or inherently disclose the element of using "homogenized cream."

As discussed above, Applicants contend that R1 cannot anticipate claims 1-3, 6-10, and 12. Nevertheless, solely to expedite prosecution, Applicants have amended independent claim 1 to recite that the yogurt comprises "7% to 14% (m/m) of a homogenized cream." Likewise, process claim 6 recited "mixing ...with 7% to 14% by weight of homogenized cream." Thus, in addition to the arguments set forth in the previous paragraphs, R1 also does not anticipate claim 1 because R1 does not recite a yogurt comprising "7% to 14% (m/m) of a homogenized cream" or the mixing step of claim 6. Because R1 cannot anticipate independent claim 1, this reference cannot anticipate claims 2 and 3.

For the reasons set forth above, R1 does not expressly or inherently anticipate claims 1-3, 6-10, and 12. Applicants therefore request that the Office withdraw this rejection.

**B. Rejection of claims 1 and 2 under 35 U.S.C. § 102(b), as allegedly anticipated by Van Dijk et al. (GB 1,476,309).**

The Office rejects claims 1 and 2 under 35 U.S.C. § 102(b), as allegedly anticipated by Van Dijk et al. (GB 1,476,309); hereinafter R2). Office Action, p. 3. According to the Office:

7. R2 discloses a process in which cream is admixed with an acidified milk product and whipped to produce a whipped topping. (page 1, col. 1, line 31 to col. 2, line 59).

8. R2 discloses a formulation where yogurt is mixed with cream to make a whipped topping. (Page 2, Example 2).

9. R2 teaches that additional sugar, flavors and other additives can be incorporated into the mixture. (page 2, col. 1, lines 15-18).

Office Action, p. 3. With regard to claim 2, the Office then raises the same inherency anticipation argument which it raised over R1, and contends that "[g]iven that cream and yogurt are mixed to make the final product, the particle diameter for the free fat globules and protein-fat globules as presently claimed will be inherent in the finished product." Office Action, p. 3. Applicants respectfully traverse.

The Office has not met its burden because it failed to identify extrinsic evidence, or indeed any basis, to explain why mixing fermented yogurt with cream necessarily and inevitably results in the diameter sizes recited in claim 2. R2 does not teach specific compositions that necessarily and inevitably have a bimodal structure, much less that the bimodal structure would have fat globules with the specific particle diameters recited

in claim 2. Nor is there any reason articulated by the Office or in R2 for one of skill in the art to believe that by following the broad recommendations in R2 for preparing the compositions of R2, the required bimodal structures would necessarily and inevitably have been formed.

Moreover, Applicants submit that R2 cannot anticipate claim 1 at least because R2 does not teach the "bimodal structure" of claim 1. Finally, Applicants submit that just as R1 does teach "homogenized cream," neither does R2. Thus, because R2 does not teach each and every element of independent claim 1, either expressly or inherently, R2 cannot anticipate claims 1 and 2. Applicants therefore request that the Office withdraw this rejection.

#### **IV. REJECTIONS UNDER 35 U.S.C. § 103**

##### **A. Rejection of claims 4, 5, and 11 under 35 U.S.C. § 103(a), as allegedly unpatentable over R1.**

The Office rejects claims 4, 5, and 11 under 35 U.S.C. § 103(a), as allegedly obvious over R1. Office Action, p. 3. Applying R1 as discussed above, the Office further contends:

14. While R1 is silent regarding a chocolate flavored product or a vanilla flavored product containing chocolate chips, given that R1 discloses the incorporation of flavoring agents into the product, it is obvious to those of skill in the art that flavors such as chocolate flavor on its own or vanilla flavor and chocolate chips can be added to the formulations disclosed by R1.

15. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the yogurt product of R1 by adding either chocolate flavor or vanilla flavor containing chocolate chips to the product. One

would do so to make various flavors of a base mix. Absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in making a yogurt product containing added cream in various flavors.

Office Action, pp. 3-4. Applicants respectfully traverse.

The MPEP specifies that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP 2141(III). The Supreme Court in *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007) confirmed that the analysis supporting such a rejection should be made explicit (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness here because the Office has not met the burden of providing reasons for why it would have been obvious to modify R1 in order to obtain the bimodal structure recited in claim 1, upon which claims 4 and 5 depend.

At a minimum, the Office bears the burden to show how all of the claimed limitations are either taught or suggested by the cited prior art (R1). In the Office Action, the Office apparently proceeds under the assumption that R1 teaches everything in claims 4, 5, and 11, but for the limitation "regarding a chocolate flavored product or a vanilla flavored product containing chocolate chips." Office Action, p. 4. However, as Applicants argued in the anticipation section, R1 also fails to teach or suggest the "bimodal structure" and "homogenized cream" elements of claim 1 and therefore claims 4 and 5. Moreover, the Office has not explained why an alleged general teaching regarding "flavoring agents" would have rendered the specific flavors of chocolate or vanilla with chocolate chips obvious.

Likewise, R1 fails to teach or suggest the use of "homogenized cream" as recited in process claim 6, upon which claim 11 depends. If anything, R1 even teaches away from homogenized cream, by teaching the use of "pasteurized cream." See R1, page 9, line 21. Thus, one of skill in the art would not have used homogenized cream in reproducing the teaching of R1. Therefore, the Office has not met its burden to show how the recited use of "homogenized cream" would have been obvious based on the alleged teachings of R1.

For all the reasons set forth above, R1 would not have rendered claims 4, 5, and 11 obvious. Applicants therefore request that the Office withdraw this rejection.

**B. Rejection of claims 3-12 under 35 U.S.C. § 103(a), as allegedly unpatentable over R2.**

The Office rejects claims 3-12 under 35 U.S.C. § 103(a), as allegedly obvious over R2. Office Action, p. 4. The Office proceeds in multiple steps. Applying R2 as discussed above, the Office further contends:

18. R2 is silent regarding the flavorings as presently claimed.

19. Given that R2 discloses the addition of flavors of choice, it would be obvious to those of skill to incorporate flavors as presently claimed.

Office Action, p. 4. Up to ¶19, the Office has failed to address the "bimodal structure" element. The Office then acknowledges that "the cream and yogurt proportions as disclosed by R2 are slightly different from cream and yogurt proportions as presently claimed . . . ." Office Action, p. 5 (emphasis added). The Office adds that "since varying the cream and yogurt proportions would result in different overruns (as



disclosed by R2), different whipping properties . . . flavors, and . . . caloric values, one would be motivated to changes those proportions for any of the mentioned reasons."

Again, none of these allegations by the Office address the "bimodal structure" of independent claim 1, upon which claims 3-5 depend, and of claim 12. Subsequently, in ¶21 the Office only addresses the kinds of mixing (in-tank and in-line). Office action, p. 5. When discussing bimodal structure, the Office offers an unsupported, conclusory allegation that "absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in making a bimodal yogurt of different flavors as presently claimed." Office Action, p. 5. Applicants respectfully traverse.

The Office has failed to establish a *prima facie* case of obviousness. First, the Office does not articulate any reasoning as to how R2 teaches or suggests the recited "bimodal structure" of independent claim 1. Neither does the Office articulate how one of ordinary skill in the art would have found R2 to suggest the use of "homogenized cream," as taught in claim 6, upon which claims 7-11 depend. Consequently, R2 does not render claims 3-12 *prima facie* obvious.

Second, the Office repeatedly alleges that one of skill in the art would be "motivated to change . . . [the] proportions" of cream to milk. Office Action, p. 5. Yet, such motivation and such change would still not lead to the claimed compositions and processes, because changing the *proportions* of cream to milk does not speak to the presence of "homogenized cream" in the yogurt or the use of "homogenized cream" in a process of yogurt-making. Applicants note that neither R1 nor R2 teach the use of homogenized cream.

In sum, the Office has not set forth any reason why a person of ordinary skill in the art would have had both motivation to modify R2 to achieve the claimed invention and a reasonable expectation of success in doing so. Consequently, the Office has not met its burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2143. Applicants respectfully request that this rejection be withdrawn.

**V. CONCLUSIONS**

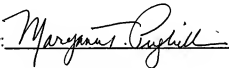
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of claims 1-12.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 13, 2009

By:   
Maryann T. Puglielli  
Reg. No. 52,138  
(202) 408-6054